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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,902	11/24/2003	Alan L. Billings	930034-2041	5301

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,902

Applicant(s)

BILLINGS ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/17/04, 1/31/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species
(Applicant must pick one Species within each Group):

Species Group I

Species A (appears to be claims 1-8), drawn to a surface of the base structure having a plurality of grooves.

Species B (appears to be claims 9-15), drawn to a surface of the base structure having a plurality of holes.

Species Group II

Species X (appears to be claims 6, 12), drawn to the grooves extending partially through the resin layer forming an impermeable layer.

Species Y (appears to be claims 7, 13), drawn to the grooves extending through the resin layer forming a permeable layer.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic to Species Group I while claims 1 and 9 are generic to Species Group II.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. During a telephone conversation with Mr. Santucci on 3/14/06 a provisional election was made with traverse to prosecute the invention of Species A and Species X, claims 1-6 and 8.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 7 and 9-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billings et al. (US 6470944, listed in IDS) in view of McGahern et al. (US 6428874, listed in IDS) and further in view of Hansen (US 2002/0102894).

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With respect to claim 1, Billings teaches a single facer corrugator belt 40 comprising a base structure 52 formed by machine direction yarns 56 and cross-machine direction yarns 54 and a polymeric resin layer 66 applied to at least one surface of the base structure (Figure 2; abstract; column 3, lines 10-18; column 4, lines 43-48). In fact, Billings teaches coating **and** impregnating the base structure with the resin so that complete impregnation of the base structure takes place because complete impregnation of the base structure, in addition to forming a distinct resin layer on the outside surface of the base structure, improves the integrity and durability of the belt (column 4, lines 43-48).

It is unclear as to whether Billings teaches a plurality of grooves formed on at least one surface of the base structure.

It is known in the paper processing art to make a long nip press belt comprising a base structure formed by machine direction and cross-machine direction yarns and a resin layer that coats and impregnates the base structure so as to completely impregnate the base structure in addition to forming a distinct resin layer on the outside surface of the base structure, as taught by McGahern (Figure 3; abstract; column 4, lines 45-47; column 5, lines 20-22). McGahern teaches the base structure having a plurality of grooves formed on the distinct resin layer that forms the outside surface of the base structure, wherein the grooves are for temporarily storing water that is removed from the paper material as it is conveyed on the base structure (abstract; column 2, lines 61-62).

Therefore, it would have been obvious to one of ordinary skill in the art to have a plurality of grooves formed on the distinct resin layer that forms the outside surface of the base structure of Billings because such is known in the art, as taught by McGahern, where grooves

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allow for the temporary storage of water that is removed from the paper material as it is conveyed on the base structure; especially since it is known in the paper processing art to make a belt from machine and cross-machine direction yarns that can be used as a base structure for either a long nip press belt or a corrugator belt, wherein the base structure has passages/grooves for conveying water away from the paper material being conveyed thereon and temporarily storing the water, as taught by Hansen (sections [0015, 0021, 0052]).

Regarding claim 2, Billings in view of McGahern teaches such (column 6, lines 46-47 and 57-58).

Regarding claim 3, whether to use continuous or discontinuous grooves would have been within purview of the skilled artisan especially since one reading McGahern as a whole would have appreciated that the reference is not concerned with particular grooves.

Regarding claims 4-5, Billings teaches such (column 4, lines 2-18 and 43-48).

Regarding claim 6, Billings in view of McGahern teaches such (see Figure 3 of McGahern).

Regarding claim 8, Billings teaches such (column 3, lines 10-18) and/or Billings in view of McGahern teach such (column 4, line 58 – column 5, line 4).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-6 and 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,470,944 in view of McGahern et al. and further in view of Hansen.

The claims of the '944 Patent teach all the limitations except a plurality of grooves formed on at least one surface of the base structure. Please refer to paragraph 5 above for a complete discussion of McGahern and Hansen and a statement as to why it would have been obvious to modify the '944 patent in view of these references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JESSICA ROSSI
PRIMARY EXAMINER

